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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,995	02/09/2001	Ken Kutaragi	SCEI 18.302	5881

7590 05/15/2008

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EXAMINER	
ALVAREZ, RAQUEL	

ART UNIT	PAPER NUMBER
3688	

MAIL DATE	DELIVERY MODE
05/15/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/780,995	KUTARAGI ET AL.	
	Examiner	Art Unit	
	Raquel Alvarez	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 February 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date. _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to communication filed on 2/27/2008.

2. Claims 21-25 have been canceled. Claims 1, 4, 5, 12 and 13 have been canceled.

3. Claims 1-20 are presented for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-6, 8, 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (5,835,087 hereinafter Herz) in view Ebisawa (5,946, 664 hereinafter Ebisawa).

With respect to claims 1, 4-6, 8, 11-18, Herz teaches an in contents-advertising method wherein advertisement information provided beforehand is included in digital contents activated by a user terminal (Summary). Activating in a user terminal in a program by a user the digital content and determining that the digital contents have been activated by the user (col. 55, lines 45-54); transferring an identifier of the digital contents and an identifier of the user to an advertising information server when the digital contents have been activated by the user (col. 55, lines 45 to col. 56, lines 1-14); selecting and retrieving advertising information by the advertising information server

based on the digital contents identifier and the user identifier and transferring the retrieved advertising information to the user terminal (col. 60, lines 11-20); inserting the retrieved advertising information in the digital contents such that the advertising information is automatically selected and retrieved from the advertising server, transferred to the user terminal and inserted in the digital contents when the digital contents are activated in the user terminal by the user (col. 55, lines 45 to col. 56 lines 1-14; col. 60, lines 11-20 and col. 61, lines 4-26); information indicating that advertisements may be inserted, advertising information included in the digital content is updated with the retrieved advertising information. In Herz, the lists of advertisements are pre-selected based on the target profile of the article (col. 55, lines 50-62) and the amount that advertisers are willing to pay (col. 40, lines 8-28); receiving input from the user via a user interface of the program after transferring of the retrieved advertising information. In Herz, the advertisements are selected and retrieved based on target profile of the news programs (col. 55, lines 50-62) and based on the amount of money the advertisers are willing to pay (col. 40, lines 8-28). The advertisements are pre-selected before the user interacts with the new news program.

With respect to the digital contents being activated in a game program. Ebisawa teaches activating contents in a racing game program (Abstract and Figure 4). It would have been obvious to a person of ordinary skill in the art to have changed the news service program of Herz to a game program of Ebisawa in order to attract fun, younger users to the system.

With respect to counting the number of times that the retrieved advertising

information is transferred and billing the advertiser based on the number of time that the advertisement is retrieved. Official Notice is taken that it is old and well known to count the number of times that a user clicks on advertisements in order for advertisers to get billed only for advertisements that are received. For example, advertisers paying for clickthroughs is old and well known to determine the number of time that a user retrieves an ad and to allow the advertisers to be billed based on the clickthoughs. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included counting the number of times that the retrieved advertising information is transferred in order for the advertisers to be billed for ads that have been retrieved.

With respect to claims 2-3, Herz further teaches providing the advertising information by the advertising server to the contents provider for insertion in the digital contents (Figure 1).

Claim 19 further recites the digital contents including a moving image and the advertising information is included in the predetermined part of the digital contents. Ebisawa teaches a driving game (digital content), the advertisements A-C being displayed in a predetermined scene or location of the racing game in order to target the ads based on the moving images. It would have been obvious to a person of ordinary skill in the at the time of Applicant's invention to have included the digital contents including a moving image and the advertising information is included in the

predetermined part of the digital contents in order to achieve the above mentioned advantage.

Claim 20 further recites that the program a driving game program and it includes a vehicle operated by the user and the advertisement being provided on the exterior of the vehicle. Official Notice is taken that it is old and well known for game programs and the like to provide different life like features such as vehicles and allowing the user to drive or manipulate these features in order to provide a life like experience for the users. Advertising on different locations such as vehicle's exterior is old and well known to attract the user's attention. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included a vehicle operated by the user and placing advertisements on the exterior of the vehicle in order to achieve the above mentioned advantage.

5. Claims 7 and 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Herz in view of Ebiswa further in view of Wiser et al (6,385,596 hereinafter Wiser).

Claims 7 and 9, further recite recording the transmission state of information and imposing fees based on said recording results. Wiser teaches lower quality "clips" are available as free sample for previewing while high fidelity audio image are available for purchase (see Figure 14). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included fees based on said recording results in order for advertisers to get paid for high fidelity recording products.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herz and Ebisawa further in view of Duczmal et al. (7,146,567 hereinafter Duczmal).

Claim 10 further recites the advertisement information providing system providing said advertisement creating system with the structure information and time information that can be made and providing the advertisements with the information specified by the advertiser. Duczmal teaches on Figure 3, an advertiser accesses the central server to select display locations and time slots for their advertisement to be displayed. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the advertisers selecting from certain information insertion that can be made in order for advertisers to pick from information and time slots that are available.

Response to Arguments

7. Applicant's arguments filed 2/27/2008 have been fully considered but they are not persuasive.

8. With respect to the Official Notice that was taking pertaining to "billing an advertiser for advertising fees calculated by the number of times that an advertisement is transferred". The examiner relied on clickthroughs which are old and well known to determine the number of times that a user retrieves an ad and to allow the advertisers

to be billed based on those clickthoughs. Applicant argues that "clickthroughs" do not disclose the claimed invention which require counting the number of time that the advertisements are retrieved. The Examiner wants to point out that to patent no. 6,904,408 issued to McCarthy supports the Official Notice taken, see col. 10, lines 59-65 "Clickthrough: A clickthrough is what is counted by the sponsoring site as a result of an ad click. In practice, click and clickthrough tend to be used interchangeably. A clickthrough, however, seems to imply that the user actually received the page instead of request only. Some advertisers are willing to pay only for clickthroughs rather than for ad impressions". Therefore contrary to Applicant's arguments clickthroughs implies that the user received(downloaded/retrieved) the page.

9. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

10. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Examiner wants to point out that Wiser was cited for teaching fees based on recording results. In Wise high quality will have a price and low inferior quality clips will be free of charge. The Examiner wants to point out that since the combination of

Herz and Ebisawa teach the information being advertisements then one of ordinary skilled in the art would have been motivated to include in the advertisements of Herz and Ebisawa the teachings of Wiser of having fees imposed based on the recording state in order to motivate high quality products. The Examiner wants to point out that the combination of Herz and Ebisawa are being combined with the teachings of Wiser to teach the claimed invention.

11. With respect to claim 10, Applicant argues that there is no motivation to combine Herz and Ebisawa to include the teachings of Duczmal, the Examiner wants to point out that Duczmal is being used to modify the combination of Herz and Duczmal's advertisements based on the teachings of Duczmal of selecting from displayed time slots in order to allow the users to pick or selects the advertisements of Herz/Ebisawa based on what is available. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation came from knowledge generally available to one of ordinary skilled in the art.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Point of contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

Raquel Alvarez
Primary Examiner
Art Unit 3688

R.A.
5/12/2008